Supreme Court, U.S.
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No. 00-1346

IN THE
SUPREME COURT OF THE UNITED STATES

MOORE NORTH AMERICA, INC.,

Petitioner,

v.

THE STANDARD REGISTER COMPANY,

Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals for the Federal Circuit

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OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Question 1: Whether it is inappropriate for a patentee to use the doctrine of equivalents to read meaningful limitations completely out of patent claims, such that the public — relying on the statutory notice requirement for claims — could be ensnared in an infringement trap.

Question 2: Whether an issue that the petitioner found unimportant in its appeal (it devoted exactly **one** conclusory sentence to it in its appeal brief below) is now sufficiently compelling to serve as the basis for the Court to grant *certiorari*.

LIST OF PARTIES PURSUANT TO RULES 14.1(b) AND 29.6

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief in Opposition to Petition for Writ of Certiorari.

Respondent The Standard Register Company ("SRC") is not owned by a parent corporation, nor does any public company own at least 10% of SRC.

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BRIEF IN OPPOSITION

Respondent, The Standard Register Company ("SRC"), respectfully submits this Brief in Opposition to the Petition for a Writ of Certiorari of Moore North America, Inc. ("Moore").

Moore petitions the Court to overturn a panel decision of the United States Court of Appeals for the Federal Circuit.[1] The panel affirmed a determination by the United States District Court of the Eastern District of Virginia that there was no infringement of United States Patent Nos. 5,201,464 ("the '464 patent") and 5,253,798 ("the '798 patent").[2] The Federal Circuit subsequently denied Moore's petition for rehearing and suggestion for rehearing *en banc*.

STATEMENT OF THE CASE

Respondent disagrees with the Statement of the Case set out by petitioner and hereby submits its Statement in Opposition.

On December 22, 1997, Moore sued SRC, alleging infringement of four United States patents — the '464 patent, the '798 patent, and two other patents which are not before the Court.[3] The two patents at issue in Moore's *certiorari* petition

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[1] Judge Newman concurred in part and dissented in part.

[2] The entire panel agreed that there was no infringement of the '798 patent and claim 1 of the '464 patent, but for different reasons. Judge Newman dissented from the majority holding regarding claims 9, 16, 17, and 19 of the '464 patent.

[3] The Federal Circuit unanimously held that SRC did not infringe U.S. Patent 5,314,110. Moore has not sought review of that

concern the folding patterns, including adhesive placement, on what are known as "business mailer forms," such as those used for the W-2 and 1099 statements mailed to taxpayers.

With respect to the patents at issue, Moore eventually conceded that there was no literal infringement. However, attempting to rewrite history and eliminate meaningful structural limitations from its claims, Moore argued that there was infringement of each under the doctrine of equivalents.

The structure of the accused products was undisputed. Accordingly, because there were no factual disputes concerning any of the accused products, SRC moved for summary judgment of non-infringement as to each patent. Before SRC's summary judgment motions were fully briefed, Moore's counsel spent several days inspecting SRC's documents and selecting those documents he thought important enough to have copied.[4]

On March 20, 1998, the district court, after considering Moore's opposition papers, granted summary judgment of non-infringement of the '798 patent. The district court considered, but rejected, the conclusory declarations by Moore's counsel

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decision. The district court granted summary judgment to SRC on U.S. Patent 4,918,128. Moore did not appeal that decision.

[4] Moore complains that SRC subsequently did not provide it with the documents. Pet. at 19 n.15. That statement is an example of how Moore has been reduced to distorting the record in an attempt to manufacture a cert-worthy question. What Moore fails to tell the Court is that it specifically asked SRC to **not** supply it with those documents as a cost-saving measure. Letter from Vanderhye to Enos, March 25, 1998 (Appendix A). This request came before the district court granted summary judgment on the '464 patent on April 17, 1998.

which simply stated that additional discovery was required; the court found that no "specific expected disclosures that could alter the court's conclusions and findings" were offered. Pet. App. at 79a.

On April 17, 1998, after a motion for reconsideration was submitted by SRC, the district court granted summary judgment of non-infringement of the '464 patent. It found that to permit Moore to use the doctrine of equivalents with respect to claim 1 of the '464 patent would "remove entirely 'the majority of lengths limitation' from the claim." Pet. App. at 63a. The district court also recognized that the remaining independent claims of the '464 patent (9, 16, 17, and 19) contain at least ***three*** distinct limitations which "***admittedly do not exist*** in defendant SRC's accused form." *Id.* at 64a (emphasis added). The district court refused to permit Moore to use the doctrine of equivalents to entirely eliminate these three additional structural limitations from the claim. *Id.*

On Moore's appeal, the Federal Circuit fully considered, but rejected, Moore's contentions. In rejecting Moore's contention regarding claim 1 of the '464 patent, the panel correctly followed the Court's teaching that "the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole." Pet. App. at 27a (*quoting Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997)). The panel also enunciated another reason for affirming the finding of non-infringement of claim 1 — namely, that a strip of adhesive that has a length equal to 99% of the length of another strip is not "substantially less" in length than that other strip.[5] Pet. App. 29a n.1. This

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[5] Thus, even were *certiorari* to be granted here and the decision of the Federal Circuit vacated with respect to claim 1 of the '464

was the reason why Judge Newman concurred in the finding of non-infringement of claim 1. Pet. App. 56a.

As to claim 9, the majority relied on the Court's guidance in *Warner-Jenkinson* to determine that Moore was attempting to violate the All Elements Rule. Pet. App. 32a, citing *Warner-Jenkinson*, 520 U.S. at 29-30. Moreover, the majority expressly ***adopted*** Moore's arguments concerning *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929) but, based on the undisputed facts of the case, still found there to be no infringement.

SUMMARY OF ARGUMENT

Appeals from the circuit courts of appeal are heard by the Court ***only*** for compelling reasons. *See* Sup. Ct. R. 10. This fact-specific case presents no such compelling reason. Petitioner's questions for review present hypothetical issues and lack factual foundation. Petitioner's argument, devoid of the rhetoric, is that the Federal Circuit panel incorrectly applied the correct law. When petitioner's questions are properly recast in the form of respondent's questions for review, the answers become obvious. To the first question, the answer is yes: it is, as the Federal Circuit held, inappropriate for a patentee to use the doctrine of equivalents to completely read meaningful limitations out of patent claims. The answer to the second question is no: an issue that the petitioner found so unimportant in its appeal that it devoted exactly **one** conclusory sentence to it is not sufficiently compelling for the Court to grant *certiorari*.

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patent, it would be an exercise in futility because the Federal Circuit would just reaffirm based upon this alternative basis.

ARGUMENT

I. THERE IS NO CONFLICT BETWEEN THE COURT'S PRECEDENT AND THE DECISION OF THE FEDERAL CIRCUIT.

The Federal Circuit panel looked to the Court's opinion in *Warner-Jenkinson* for guidance in deciding the present case. It did precisely what it was supposed to do and, indeed, had been instructed by the Court to do. Now attempting to create the illusion of a lower court run amok, Moore parses threads of language from various opinions of the Court and then weaves those threads into a tapestry of woe. Moore's fundamental problem, though, is that, when the tapestry is held up to the light of objective examination, it unravels.

The Federal Circuit did not "speak the death of the doctrine of equivalents" in this case. Nor is the patent system itself in jeopardy, despite Moore's protestation to the contrary. This is a simple case, with simple and undisputed facts and clearly applicable law. All that was done here was that the lower court interpreted the claims, as a matter of law, and compared those claims to the accused products. Noting that petitioner had acknowledged that literal infringement did not exist, the panel then reviewed infringement under the doctrine of equivalents.

In every instance, the Federal Circuit found that petitioner was attempting to use the doctrine to entirely vitiate claim limitations. The panel looked to the Court's recent precedent concerning the doctrine of equivalents and heeded the Court's warning that patentees cannot use the doctrine of equivalents to vitiate a claim element. *See Warner-Jenkinson*,

520 U.S. at 29, 34, 40. Indeed, the lower court cited to *Warner-Jenkinson* not ***once***, but ***ten*** separate times.

A. The Court Should Deny *Certiorari* on the First Question Presented.

All of the questions presented by Moore are inappropriate as a basis for the Court to grant *certiorari*. The first question does not even ascribe error to the lower court.[6] Perhaps its hypothetical question might make for a marginally interesting law review article, but the Court should not issue "advisory opinions on abstract propositions of law." *Hall v. Beals*, 396 U.S. 45, 48 (1969). In addition, the question is factually wrong because a functional analysis **was** performed by the lower court.

Perhaps misunderstanding *Warner-Jenkinson*, petitioner then misapplies that case to the present facts. Petitioner argues that, under *Warner-Jenkinson*, the doctrine of equivalents must apply "absent prosecution history estoppel or prior art." Pet. at 9. However, petitioner is wrong. This Court held in *Warner-Jenkinson* that, "if prosecution history estoppel would apply **or** if a theory of equivalents **would entirely vitiate** a particular claim element," the plaintiff **cannot** resort to the doctrine of equivalents to prove infringement. *Warner-Jenkinson*, 520 U.S. at 39 (emphasis added). Therefore, even if the Court were to consider reviewing this hypothetical question, it still should not grant *certiorari*.

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[6] The first question presented by Moore is: "Whether a functional analysis under the doctrine of equivalents can be summarily barred as a matter of law, where prosecution history estoppel does not apply." Pet. at i.

In addition, the Court should not grant *certiorari* in any event on the '798 patent because Moore's entire argument below regarding infringement of the '798 patent under the doctrine of equivalents was **one sentence**. The sole sentence stated that "there would be infringement under the doctrine of equivalents since the SRC forms are directly competitive with the Moore forms sold under the '798 patent." Brief for Appellant Moore at 33 (Appendix B). First, Moore provides no case law, nor could it, that holds that a product must infringe under the doctrine of equivalents if it is competitive with a patented product. More important, it defies logic for Moore to argue that this argument, which was worth one sentence below, is now so compelling that the Court should grant *certiorari* on its basis.

B. The Court Should Deny *Certiorari* on the Second Question Presented.

Respondent also disagrees with petitioner's second question.[7] Once again, the question is factually wrong because the lower court found that SRC had done more than "rearrange claim elements." Rather, it had entirely eliminated certain claim elements. Even if Moore's question were factually accurate, Moore cannot claim that a **compelling** question of law is presented because the panel found that, on the basis of the undisputed facts of the case, it would be impossible for "the transverse line of weakness . . . [to] be on the opposite side from said second section," as required by the corresponding claims of the patent. Pet. App. at 30a-31a (internal quotations omitted). Neither below nor in its petition did Moore ever offer

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[7] The second question presented by Moore is: "Whether the Federal Circuit can deny, as a matter of law, application of the doctrine of equivalents to rearranged claim elements." Pet. at i.

any explanation as to how its desired scope of equivalents would accommodate the omission in the SRC form of the "opposite side" requirement that the Federal Circuit pointed out. Pet. App. at 30a-31a.

Petitioner's reliance upon *Sanitary Refrigerator* with respect to these claims is therefore misplaced. As the court of appeals noted, *Sanitary Refrigerator* was an ordinary doctrine of equivalents case involving the ***replacement*** of an element with an insubstantially different element.[8] Pet. App. 32a. But even under Moore's theory of equivalents as to these claims, it could find no replacement for the "opposite" limitation.[9]

Nevertheless, Moore claims that the panel ignored the holding of the Court in *Sanitary Refrigerator*, 280 U.S. 30 (1929), relying instead on its own precedent. But what the lower court actually ***said*** on this issue — after a lengthy exposition of why Moore's arguments were incorrect — was that, "even assuming, as Moore argues, that *Sanitary Refrigerator* does allow the rearrangement of claim limitations, such rearrangement must not 'effectively vitiate [an] element in its entirety.'" Pet. App. at 32a (*quoting Warner-Jenkinson*, 520 U.S. at 29). Thus, in the alternative, the lower court actually ***accepted*** Moore's contentions but found that, even so, no infringement could be found. Moreover, *Sanitary Refrigerator* explicitly states that its holding is ***inapplicable*** "where form is of the essence of the invention." 280 U.S. at 42. In this crowded art, form — i.e., the location and

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[8] For example, if a patent claimed an adhesive comprising A + B, an adhesive comprising only A could ***never*** be the equivalent thereof, no matter how much A was used.

[9] The dissent below also overlooked this point.

dimensions, such as length, of the claim elements — is plainly "of the essence of the invention," as exemplified by the ***extremely*** detailed description of those elements in the claims. *See* Pet. App. at 140a-148a, 164a-165a. Indeed, petitioner has never suggested otherwise.

Additionally, petitioner has confused "reciprocal changes" in an accused product, as referred to in *Sanitary Refrigerator,* with the complete obviation of specific claim elements. Here, there was no "reciprocal change." Instead, SRC completely eliminated certain claim elements. Thus, the panel correctly did not allow a finding of infringement on those facts. *See* Pet. App. at 31a. *Sanitary Refrigerator* never held that a party could be liable for infringement when it did not practice **every** element in the claim. No authority whatsoever exists for **that** proposition!

In addition, as with claim 1, even were the Court to grant *certiorari*, vacate, and remand, the Federal Circuit noted that Moore did not contest the district court's finding that SRC's forms did not include several additional claim elements. Consequently, the panel held that "their absence would provide yet another ground for affirming the district court's grant of summary judgment." *See* Pet. App. at 33a n.2. Thus, again, on remand the lower court would simply reaffirm its holding upon the alternative basis set forth in its footnote 2.[10] Again, it

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[10] Moore ***now*** argues, as it did for ***the first time*** in its request for reconsideration below, that it does dispute the lower court's statement. Petitioner tries to finesse this point by arguing in the present tense: "Petitioner *does* argue that Respondent's accused form includes the other identified elements." Pet. at 11 n.8 (emphasis in original). Regardless of what Moore is now arguing, the Court should not "consider issues raised clearly for the first time in a petition for rehearing." *Adams v. Robertson*, 520 U.S. 83, 89 n.3 (1997).

would be a waste of the Court's resources to consider this issue.

C. The Court Should Deny *Certiorari* on the Third Question Presented.

Respondent also disagrees with petitioner's third question.[11] The Federal Circuit did not conclude that a strip of adhesive running 47.8% of the length of a business form is not equivalent to the claim requirement that the adhesive extend over a "majority" of the length of the form "without any functional analysis." Rather, the lower court implicitly accepted that the function of the adhesive in the accused form was the same as the function required by the claim element but found, as a matter of law, that to permit the doctrine of equivalents to reach what is the antithesis of the claim element would require the complete vitiation of that important claim element.

Similarly, petitioner's efforts to characterize as "swallow[ing] the doctrine of equivalents" the panel's decision that a majority amount did not include the minority amount of 47.8% are not compelling. *See* Pet. at 15. As evidenced by the patent specification itself, the "majority" limitation was an important claim element.[12] As the lower court held, a "minority" is the very antithesis of the term "majority" and, therefore, no reasonable juror could find a minority (be it

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[11] The third question presented by Moore is: "Whether the Federal Circuit can conclude that 47.8% is not equivalent to 'majority' as a matter of law without any functional analysis." Pet. at i.

[12] The specification disclosed other embodiments but did not claim those embodiments. Thus, the applicant must have considered the "majority" limitation to be important or "of the essence."

49.9% or 0.1%) to be the equivalent of a majority.[13] Pet. App. at 27a. Again Moore cannot demonstrate that it is a **compelling** question of law for the Court to decide the factual issue of whether a minority (*i.e.*, 47.8%) is equivalent to a majority.

D. The Court Should Deny *Certiorari* on the Fourth Question Presented.

Question 4 is likewise factually flawed.[14] It is based upon a misapprehension of what the Federal Circuit did and an erroneous attribution of "dedication estoppel" to the panel. Fundamentally, the lower court affirmed because it refused to allow Moore to entirely vitiate a claim element. It also noted that Moore had dedicated to the public an embodiment which, had it been claimed, might have allowed coverage under the doctrine of equivalents. The latter observation, which Moore characterizes as a new doctrine recently developed by the Federal Circuit in contravention of the Court's precedent, was actually espoused by the Court in *Miller v. Bridgeport Brass*

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[13] Were there to be any other result, this important limitation would be completely eliminated, as pointed out by the lower court. Pet. App. at 26a. This case is distinguishable from a case in which a numerical recitation is supplied. Suppose, for example, a claim included the numerical limitation of "5." Well, "4" is not the antithesis of 5, so it is possible that the doctrine of equivalents could reach a product including "4." Hence, the Federal Circuit's decision on remand in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 114 F.3d 1161, 1164 (Fed. Cir. 1997). However, the doctrine simply cannot be used to cover something that is the very antithesis of what is claimed.

[14] The fourth question presented by Moore is: "Whether the Federal Circuit can deny application of the doctrine of equivalents as a matter of law by employing its 'dedication' estoppel theory, an approach already rejected by this Court." Pet. at i.

Co., 104 U.S. 350, 352 (1881) ("The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed."). Moreover, the Court has relatively recently reaffirmed the vitality of the holding in *Miller,* noting that a feature that is not specifically claimed in the patent, but is disclosed in the drawings and specification, is "[u]nder long settled law . . . public property." *Graham v. John Deere Co.*, 384 U.S. 1, 31 n.17 (1966) (citation to *Miller* omitted). Consequently, Moore's assertion that the Court has rejected the dedication to the public of features disclosed but not claimed is flatly wrong.

Moore's assertion that this is a new rule for the Federal Circuit is also flatly wrong. The Federal Circuit has consistently been applying this rule since at least 1989 to preclude findings of infringement, both literal and equivalent. *See Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) (literal) and *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098 (Fed. Cir. 1996) (doctrine of equivalents). Thus, this is neither a new issue nor one created by the lower court.

Finally, the Court should not grant *certiorari* on this question because the Court of Appeals for the Federal Circuit has announced *en banc* consideration of this issue. *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.* (Fed. Cir. Jan. 24, 2001) (Appendix C). As the Federal Circuit has initial responsibility to ensure national uniformity with respect to patent law, the Court should allow the Federal Circuit to first address this question. *Cf. Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). *Warner-Jenkinson* stated that the Federal Circuit should fill in the details in the doctrine of equivalents law, and that is what it is doing.

E. The Court Should Deny *Certiorari* on the Fifth Question Presented.

Question 5 is also factually incorrect because it ignores the determination by the panel that the district court committed only harmless error with respect to the claim construction of but one patent.[15] In other words, the question impermissibly exaggerates what actually occurred below. The question is also factually flawed because all the information for which Moore alleged discovery was required was already in Moore's hands.[16] Moreover, it was petitioner's burden to demonstrate to the appellate court ***how*** the trial court abused its discretion by failing to give credence to Moore's conclusory declarations, but petitioner completely failed to meet its burden.

This question is especially not worthy of *certiorari* because it does not even address Federal Circuit law. As even petitioner concedes, the panel was required to apply Fourth Circuit law in determining the proper standard for admitting summary judgment evidence. Pet. at 20-21. Because the standard for admitting summary judgment evidence is based on

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[15] The fifth question presented by Moore is: "Whether the Federal Circuit can affirm summary judgement that was based upon an acknowledged error of law without permitting 'adequate time for discovery' directed to the proper rule of law and despite a timely motion under Rule 56(f)." Pet. at i.

[16] Moore ascribed error to the refusal to permit discovery into the composition of SRC's adhesive. But, as subsequently learned from confidential documents produced by Moore in a different lawsuit, Moore ***knew*** the major distinction between SRC's adhesive and its own. Moore also knew what printers existed and what SRC forms were used on what printers. Finally, Moore's counsel had inspected all of the pressure seal forms made by SRC. Quite simply, as the district court correctly noted, no fishing expedition could save Moore.

the law of the regional circuit, the Federal Circuit cannot make law in this area. *See Vivid Tech., Inc. v. American Science & Eng'g, Inc.*, 200 F.3d 795, 806 (Fed. Cir. 1999). Therefore, at worst, petitioner is alleging that the panel applied the correct law, but that it did so incorrectly. But "*certiorari* is seldom granted when the asserted error consists of an erroneous factual finding **or the misapplication of a properly stated rule of law**."[17] Sup. Ct. R. 10(c) (emphasis added).

Moreover, the Federal Circuit did correctly apply the stated rule of law. First, Rule 56(f) uses the operative word "may." Thus, a district court's decision is discretionary and can be reversed only if a party demonstrates that the court "abused its discretion." *Nguyen v. CAN Corp.*, 44 F.3d 234, 242 (4th Cir. 1995). To demonstrate an abuse of discretion regarding discovery rulings is a heavy burden. *See Curtin v. Office of Personnel Management*, 846 F.2d 1373, 1378 (Fed. Cir. 1988). Moore, never even mentioning the appropriate standard below, offers no evidence that the district court abused its discretion.[18]

Second, both lower courts concluded that Moore's Rule 56(f) declarations were wholly conclusory. It has long been the

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[17] *Certiorari* is especially inappropriate in this case because the Federal Circuit cannot make binding precedent when it is merely interpreting the law of the regional circuit. *Cf. Exxon Corp. v. United States*, 931 F.2d 874, 877 n.4 (1991) (holding that the Federal Circuit's previous interpretation of Second Circuit law should also become the law of the Federal Circuit because that law is "commonly accepted in federal jurisprudence").

[18] Moore does mention, finally, the appropriate standard in its petition, but merely offers a conclusory opinion that it has been met. Pet. at 22.

law that conclusory declarations cannot defeat a properly supported motion for summary judgment. *See, e.g., Evans v. Technologies Applications & Serv. Co.*, 80 F.3d 954, 962 (4th Cir. 1996).

Third, the entire sum and substance of Moore's Rule 56 argument in its opening brief was that the "declarations speak for themselves." Moore Br. at 16 (Appendix B). That was the ***totality*** of Moore's argument. Now, it devotes ***ten*** pages in a petition for *certiorari* to this issue, ascribing error to the lower court. Pet. at 5-8, 17-23. If there was error, which there was not, it was (a) induced by Moore's ***one***-sentence brief and (b) is of a type not ordinarily reviewed by the Court. *See* Sup. Ct. R. 10. Moreover, the record demonstrates that more discovery would not have helped Moore.[19] Therefore, it cannot be error, let alone an abuse of discretion, for the district court to have refused to extend discovery.

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[19] The record demonstrates that Moore ***did*** meet SRC's motions. *See* Pet. App. at 202a (item 60); 203a (item 65); 205a (item 74); 208a (item 86). It did ***not*** seek postponement, as permitted by the Rule, to obtain ***specifically*** identified discovery. Although Moore protests that it needed discovery of SRC's adhesive composition, subsequent events have shown that Moore ***knew*** the major difference between SRC's adhesive and that used on the claimed forms. Moore also claims that it needed additional discovery regarding SRC forms to determine if any were used on printers like that mentioned in the '798 patent. The problems with this theory are (a) that Moore's counsel indisputably had inspected all of the pressure seal forms made by SRC ***before*** opposing SRC's motion (and thus knew what forms SRC had made) and (b) that no discovery from SRC would shed any light on the existence of other pausing printers. Quite simply, there are no printers, other than the IBM 3800, which suffer the problem that the form of the '798 patent was designed to correct. Further discovery simply would not have helped Moore oppose SRC's motions for summary judgment.

II. MOORE HAS FAILED TO RAISE ANY QUESTION THAT IS WORTHY OF THE COURT GRANTING *CERTIORARI*.

Moore has taken a "shotgun" approach to try to manufacture a single cert-worthy question out of five totally inadequate questions. Because there ***is*** no cert-worthy question, Moore is reduced to misstating facts, mischaracterizing what the Federal Circuit did, and finally using ten pages of its brief to rehash the factual basis for its claim that the Federal Circuit misapplied Fourth Circuit case law.[20] But the Federal Circuit court did not depart from the accepted and usual course of judicial proceedings so as to require the exercise of the Court's supervisory powers. It did not decide an important federal question in a way that conflicts with relevant decisions of the Court. It created no "new" law and made none of the errors attributed to it by petitioners. It did not ignore the Court's precedent, including *Warner-Jenkinson* and *Sanitary Refrigerator*; it was fully aware of that precedent and explicitly considered and applied it. It did not create a "new form of estoppel." It is the Federal Circuit that has been given initial responsibility to ensure national uniformity with respect to patent law questions such as this one. *Cf. Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). The Federal Circuit's decision in this case promotes such uniformity.

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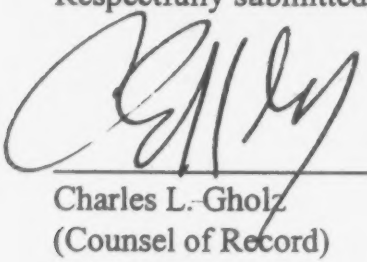
[20] The weakness of Moore's supposed cert-worthy questions is demonstrated by the fact that it spends ten pages discussing the clearly un-cert-worthy question of whether the Federal Circuit correctly applied Fourth Circuit evidentiary law, while breezing through its four other supposed cert-worthy questions in a total of ten pages.

Even if the lower court's decision were incorrect (which it most definitely is not), at best, petitioner is urging that the lower court misapplied a properly stated rule of law. Such an occurrence does not warrant the grant of *certiorari*. Sup. Ct. R. 10(c). Thus, there are no reasons, let alone ***compelling reasons,*** for the Court to grant *certiorari*.

CONCLUSION

For all the foregoing reasons, the petition for *certiorari* should be denied.

Respectfully submitted,



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APPENDIX

APPENDIX A

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VIA FACSIMILE/THEN MAIL

William T. Enos, Esq.
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1755 Jefferson Davis Highway
Arlington, VA 22202

Subject: ***Moore U.S.A., Inc. v. The Standard Register Company E.D.Va (Alexandria Division); Civil Action No. 97-2054-A Our Ref: 263-1165***

Dear Bill:

Further to our phone discussion of earlier today, I have asked that you stop copying documents identified by us for production. Any documents already copied and numbered I would appreciate you sending to us, but in view of the present status of the litigation, I suggest that SRC simply not go to the trouble and expense of copying the documents now. I hope you understand that this is merely a desire to save trouble and expense for the parties at the present time in view of the present

status of the litigation. If the status changes in the future, we can re-activate the document production on a reasonable basis. If you cannot agree to this for some reason, please advise.

As I also mentioned to you over the phone, our documents will be available for your inspection at our office on Monday, March 30, starting about 10 a.m. (if there is some change we would let you know by Thursday afternoon). You indicated you had no intention of bringing more than three people, and we ask that you do not bring more than three people. I presently expect your inspection will not take more than two days, but other time is available if necessary. After your inspection we will talk to see if you feel you really need large scale copying of documents, as opposed to small scale copying, in view of the present status.

I will provide supplementation to the interrogatory responses we specifically discussed -- pursuant to our agreement -- on Monday (probably not until Monday afternoon), verified by an officer of Moore; except that our contentions regarding infringement of the '464 patent will be provided by Tuesday, March 31.

I also recommended that after the decision on Summary Judgment for the '464 patent we discuss possibly staying the litigation in some manner pending an appeal. I presently view the desirable way of doing this as a request for certification for appeal, but would be pleased to entertain other options, such as dismissal without prejudice and staying the statute of limitations for your counterclaims, or for some aspects of the litigation, etc. I believe we need a few weeks, and ensuing events, to determine what would be cost efficient and effective for the parties, and do not expect any response from you at this time.

Please advise if there are any questions or misunderstandings.

Sincerely,

NIXON & VANDERHYE P.C.

By _____
Robert A. Vanderhye

cc: Michael C. Maier, Esq.

APPENDIX B

BRIEF FOR PLAINTIFF-APPELLANT MOORE U.S.A., INC.

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal No. 98-1386, -1387

MOORE U.S.A., INC.,

Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,

Defendant-Cross Appellant.

Appeal from Orders of the United States District Court for the Eastern District of Virginia in 97-2054-A Entered March 20, 1998 and April 17, 1998 By the Honorable Albert V. Bryan, Jr.

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. . . .VI. ARGUMENT

A. The Lower Court Improperly Denied Moore Relevant Discovery, and Improvidently Granted Summary Judgment

With respect to each and every patent at issue, the lower court inappropriately disposed of the patent in a summary manner without allowing Moore appropriate discovery. Summary judgment is not appropriate when the party resisting summary judgment has had no worthwhile fact discovery and submits a declaration under Rule 56(f), as was done in this case individually with respect to each of the three patents involved.

With respect to the '110 and '798 patents, the lower court [A29] dismissed Moore's motion as not offering "any specific expected disclosure that would alter the Court's conclusions and findings" and said it was unwilling to allow Moore "to conduct 'fishing expeditions'". This was an inappropriate analysis, as an inspection of the declarations submitted [A82, 83, 73,74] reveals, which declarations speak for themselves.

With respect to the declaration under 56(f) regarding the '464 patent [A59-62], the lower court never even

considered or commented on the Rule 56(f) declaration submitted [see A36-A44].

This Court has consistently found it inappropriate for a lower court to grant summary judgment based on an incomplete record. As precisely put in *Burnside-Ott v The United States*, 985 F.2d 1574, 1582-3 (Fed. Cir. 1993):

> "'The Supreme Court has made clear that summary judgment is inappropriate unless a tribunal permits the parties adequate time for discovery'. *Dunkin' Donuts of America v Metallurgical Exoproducts Corp.*, 840 F.2d 917, 919 (Fed. Cir. 1988) (citing *Celotex Corp. v Catrett*, 477 U.S. 317, 326, 106 S.Ct. 2548, 2554, 91 L.Ed.2d 265 (1986)). Indeed, summary judgment should 'be refused where the nonmoving party has not had the opportunity to discover information that is essential to [its] opposition.' *Anderson v Liberty Lobby, Inc.*, 477 U.S. 242, 250 n. 5, 106 S.Ct. 2505, 2511 n. 5, 91 L.Ed.2d 202 (1986). . . . The fact that the government had not even responded to all of Burnside-Ott's discovery requests within the allotted discovery period and that no time remained for Burnside-Ott to file a second motion to compel also shows that Burnside-Ott was provided an inadequate opportunity for discovery. . . . Burnside-Ott must be given an adequate opportunity to discover facts as to those counts before summary judgment or other disposition would be appropriate."

Thus all three summary judgment determinations should be reversed for this reason alone.

Even if the lower court had properly concluded that it was appropriate to consider the question of infringement although Moore was denied any worthwhile discovery, the lower court erred as a matter of law in granting summary judgment with respect to each of the '464, '798, and '110 patents. . . .

In claim 1 the spacing of the position of a (single) transverse pattern of adhesive is functional, recited as "a distance sufficient to ensure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer". As the most logical interpretation of SRC's own evidence presented at the summary judgment stage shows [A70-71], the SRC forms don't have this problem -- thus SRC obviously has solved it by spacing like Moore does. Thus, either SRC has admitted that this limitation is present in its forms, or there is a fact in dispute with respect thereto. Also, as A83-85 make clear, there are SRC forms that clearly fall within the literal terms of claim 1.

Even if there were no literal infringement, which there is, there would be infringement under the doctrine of equivalents since the SRC forms are directly competitive with the Moore forms sold under the '798 patent, and perform substantially the same function in substantially the same way to get substantially the same results. [A85-87.]

Thus clearly as a matter of law the lower court erred in the interpretation of claim 1, and in finding no infringement because of this erroneous interpretation.

D. The Finding that the Claims of the '110 Patent Were Not Infringed as a Matter of Law is Based Upon an Erroneous Claim Construction, which Included the Failure to Consider the Prior Art and the Prosecution History. . . .

APPENDIX C

United States Court of Appeals for the Federal Circuit

99-1076, -1179, -1180

JOHNSON & JOHNSTON ASSOCIATES INC.,

Plaintiff-Appellee,

v.

R.E. SERVICE CO., INC. and MARK FRATER,

Defendants-Appellants.

Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., of Washington, DC, argued for plaintiff-appellee. With him on the brief were Thomas H. Jenkins, and Virginia L. Carron. Of counsel on the brief was Matthew F. Weil, Howard, Rice, Nemerovski, Canady, Falk & Rabkin, of Newport Beach, California. Also of counsel on the brief were John L. Dupre', Richard A. Wise, and Dierdre E. Sanders, Hamilton, Brook Smith & Reynold, P.C., of Lexington, Massachusetts. Also of counsel on the brief were Fay E. Morisseau, Michael R. O'Neill, McDermott, Will & Emery, of Irvine, California.

Archie S. Robinson, Robinson & Wood, Inc., of San Jose, California, argued for defendants-appellants. With him on the brief were Thomas R. Fellows and Rebecca L. Moon. Of counsel on the brief was Jack M. Wiseman, of San Jose, California

Appealed from: United States District Court for the Northern District of California

Judge Charles R. Breyer

United States Court of Appeals for the Federal Circuit

99-1076, -1179, -1180

JOHNSON & JOHNSTON ASSOCIATES INC.,

Plaintiff-Appellee,

v.

R.E. SERVICE CO. INC., and MARK FRATER,

Defendants-Appellants.

Before MAYER, Chief Judge, NEWMAN, Circuit Judge, ARCHER, Senior Circuit Judge, MICHEL, LOURIE, CLEVENGER, RADER, SCHALL, BRYSON, GAJARSA, LINN, and DYK, Circuit Judges.

ORDER

This case, having been argued before a panel of three judges on December 7, 1999, and thereafter having been referred to the circuit judges who are in regular active service and a poll having been taken,

IT IS ORDERED THAT:

The Court sua sponte orders that the case be heard en banc.

New briefs will be filed. An original and 30 copies of all briefs shall be filed and two copies shall be served on opposing counsel. Amici curiae may file briefs, due at the time of the brief that supports their position. Appellants' brief is due within 60 days of the date of this Order. The due dates for the remaining briefs shall be computed in accordance with Fed. Cir. R. 31(a).

The parties are directed to confine their supplemental briefing and oral arguments before the Court en banc to the following questions:

(1) Whether and under what circumstances a patentee can rely upon the doctrine of equivalents with respect to unclaimed subject matter disclosed in the specification.

(2) Whether in this case the jury's finding of infringement should be reversed because the patentee was foreclosed from asserting the doctrine of equivalents with respect to unclaimed subject matter disclosed in the specification.

The en banc briefs and argument shall not address other issues in the case.

Oral argument will be scheduled by later order.

FOR THE COURT

January 24, 2001 — Jan Horbaly

Date — Jan Horbaly
Clerk